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SQUIRE, SANDERS & DEMPSEY L.L.P.			NGUYEN, VAN KIM T	
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TYSONS CORNER, VA 22182			2151	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/920,362

**Applicant(s)**

KOISTINEN, TOMMI

**Examiner**

Van Kim T. Nguyen

**Art Unit**

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 59-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-64, 67-84, and 86-91 is/are rejected.
- 7) ☐ Claim(s) 65, 66 and 85 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Office Action is responsive to communications filed on July 25, 2005.

Applicant has added new claims 86-91, hence claims 59-91 are pending in the case.

Amendment to the drawings has been received and entered as the drawings fully comply with 37 CFR 1.84(p)(5). The objection to the drawing has been withdrawn.

Applicant's amendment to the specification has been received and entered. The objection of the specification has been withdrawn.

Applicant's arguments, see pages 13, filed July 25, 2005, with respect to claims 58-85 have been fully considered and are persuasive. The objection of claims 58-85 has been withdrawn.

### ***Claim Objections***

2. Claim 64 is objected to because of the following informalities:

Claim 64 recites the limitation "a second communication device (7); wherein said second communication device (7); ". It is not clear what is disclosing.

Claim 74 recites the limitation "said network control device". It is not clear whether this network control device is the same with "the first network control device" disclosed elsewhere; however, in the interest of advancing the prosecution of the case, examiner will interpret the limitation as "the first network control device."

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 59-63, 67-70, 72-73, 75, 77-84, and 86-91 are rejected under 35 U.S.C. 102(e) as being anticipated by the admitted prior art.

***Regarding claim 59***, as shown in Figures 1-3, the admitted prior art discloses:

a first interface establishing device (3) connected between the first network control device (2) and a transmitting network (4); wherein

the first communication device (1) and the first network control device (2) are connected such that a use signal (US) and a control signal (CS) are sent separately to the first network control device (see Figure 2);

the first network control device (2) and the first interface establishing device (3) are connected such that the use signal (US) and the control signal (CS) are sent separately to the first interface establishing device (see Figure 2);

the first interface establishing device (3) is adapted to send the control signal (CS) over the transmitting network (4); and

a tone generation means is provided on the far-end side of the network (5, 6, 7) for receiving the control signal (CS) after transmission through the transmitting network (4) and for generating the tone signal in response to the control signal (pages 1-5).

*Regarding claim 60*, the admitted prior art also discloses the first interface establishing device (3) comprises a compressing means (3a) for compressing the use signal, the compressed signal being sent over the transmitting network (page 3: lines 15-19; and page 4: lines 11-25).

*Regarding claim 61*, the admitted prior art also discloses a second interface establishing device (5) connecting to the transmitting network (4) ; wherein the second interface establishing device comprises a decompressing means (5a) for decompressing the use signal (USC) received via the transmitting network (4), and the tone generation means (page 3: lines 15-30).

*Regarding claim 62*, the admitted prior art also discloses a second communication device (7) and a second network control device (6), wherein the second interface establishing device (5) is adapted to combine the use signal and the tone signal; and the network control device (6) is adapted to receive the combined signal and to send it to the second communication device (page 2: lines 15-30).

*Regarding claim 63*, the admitted prior art also discloses a second interface establishing device (5) connected to the transmitting network (4); and a second network control device (6); wherein the second interface established device (5) comprises a decompressing means (5a) for

Art Unit: 2151

decompressing the use signal (USC) received via the transmitting network (4); and a control transfer means receiving the control signal and sending the control signal to the second network control device (6), wherein the second interface establishing device (5) is adapted to send the use signal (US) to the second network control device (see Figure 3; page 2: lines 15-30).

*Regarding claim 67*, the admitted prior art also discloses the tone signal generated in response to the control signal is a DTMF signal (page 3: lines 20-23).

*Regarding claim 68*, the admitted prior art also discloses the first communication means (1) is adapted to generate the control signal in response to an operation of a key (page 4: lines 1-5).

*Regarding claim 69*, the admitted prior art also discloses the transmitting network is an IP based network (page 1: lines 14-20).

*Regarding claim 70*, the admitted prior art also discloses the first communication device is a mobile phone (page 1: lines 29-32).

*Regarding claim 72*, the admitted prior art also discloses the second communication device is a mobile phone (page 2: lines 25-30).

*Regarding claim 73*, the admitted prior art also discloses the second communication device is a fixed phone (page 2: lines 25-30).

**Regarding claim 75**, the admitted prior art also discloses the first network control device (2) and the first interface establishing means (3) are constructed as separate units (see Figures 1-3).

**Regarding claim 77**, the admitted prior art also discloses the first network control device (2) and the first interface establishing means (3) are constructed as separate units (see Figures 1-3).

**Regarding claim 78**, the admitted prior art also discloses a network communication device (7) connectable directory to the transmitting network (4) such that the control signal (CS) and the use signal (USC) is transmitted from the first interface establishing device (3) to the network communication device (7).

**Regarding claim 79**, the admitted prior art also discloses the transmitting network (4) is and IP based network and the network communication device (7) is an IP phone (page 1: lines 14-20).

5. **Regarding claims 80-85**, claim 80 is method claims that have substantially all the limitations of the respective apparatus claim 59. A method claim is obvious in view of an apparatus claim and vice versa if they each contain substantially the same elements. Thus claim 80 is reject under the same basis as claim 59.

Similarly, dependent claims 81-85 are rejected under the same basis as claims 60-79.

**Regarding claim 86**, the admitted prior art also discloses an interface establishing device (3) for providing a connection over a transmitting network (4), wherein a communication device (1) is connectable to the interface establishing device (3), the interface establishing device comprising:

means for receiving a use signal (US) and a control signal (CS) separately from the communication device (1), wherein the control signal (CS) is to be used to generate a tone signal at the far-end side of the transmitting network (5c), (see Figure 2; page 3: lines 15-22, and page 4: lines 1-19); and

means for sending the control signal (CS) and the use signal (USC) separately via the transmitting network (see Figure 2; page 3: lines 15-22, and page 4: lines 1-19).

**Regarding claim 87**, the admitted prior art also discloses a compressing means (3a) for compressing the use signal, the compressed signal (USC) being sent over the transmitting network (4); (see Figure 2; page 3: lines 15-22, and page 4: lines 1-19).

**Regarding claim 88**, the admitted prior art also discloses an interface establishing device (5) for providing a connection over a transmitting network (4), wherein a communication device (7) is connectable to the interface establishing device (5), the interface establishing device (5) comprising:

means for receiving a use signal (US) and a control signal (CS) separately via the transmitting network (see Figure 2; page 4: lines 20-22);



Art Unit: 2151

means for generating the tone signal (5c) in response to the control signal (page 4: lines 22-24); and

means for combining the tone signal (TS) and the use signal (US) and sending the combined signal to the communication device (page 4: lines 24-25) .

***Regarding claim 89***, the admitted prior art also discloses the use signal (US) is sent in compressed form (USC) via the transmitting network (4), the interface establishing device (5) further comprising:

a decompressing means (5a) for decompressing the use signal received via the transmitting network (page 2: lines 16-25).

***Regarding claim 90***, the admitted prior art also discloses an interface establishing device (5) for providing a connection over a transmitting network (4), wherein a communication device (7) is connectable to the interface establishing device (5), the interface establishing device (5) comprising:

means for receiving a use signal (US) and a control signal (CS) separately via the transmitting network (see Figures 2 ); and

means for sending the use signal (US) and the control signal (TS) separately to the communication device (7), wherein the control signal (CS) is to be used to generate a tone signal (see Figure 2).

Art Unit: 2151

**Regarding claim 91**, the admitted prior art also discloses the use signal (US) is sent in compressed form (USC) via the transmitting network (4), the interface establishing device (5) further comprising:

a decompressing means (5a) for decompressing the use signal received via the transmitting network.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 64, 71, 74, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, in view of Naudus (US 6,259,691)

The admitted prior art discloses substantially all the claimed limitations, except the second network control device comprising a tone generation means.

**Regarding claim 64**, as shown in Figures 1-8, Naudus discloses a second communication device (12); wherein the second network control device (80) comprises the tone generation means (50); and the second network control device (80) is adapted to combine the use signal (70) and the tone signal (72)) and to send the combined signal to the second communication device (12).

Naudus and the admitted prior art teach analogous arts, relating to telecommunicating over a IP network, thus it would have been obvious to one of ordinary skill in the art at the time

Art Unit: 2151

the invention was made to apply Naudus' method of combining the use signal and the tone signal and send the combined signal to the second communication device to transport DTMF signals in a wide-area network without having to substantially delay the audio signal.

*Regarding claim 71*, Naudus also discloses the first communication device (10) is a fixed phone.

Naudus and the admitted prior art teach analogous arts, relating to telecommunicating over a IP network, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Naudus' method of combining the use signal and the tone signal and send the combined signal to the second communication device to transport DTMF signals in a wide-area network without having to substantially delay the audio signal.

*Regarding claims 74 and 76*, Naudus also discloses the first network control device (40) and the first interface establishing means (60); and the second network control device (80) and the first interface establishing means (60), are constructed as one unit (see Figure 3).

Naudus and the admitted prior art teach analogous arts, relating to telecommunicating over a IP network, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Naudus' method of combining the use signal and the tone signal and send the combined signal to the second communication device to transport DTMF signals in a wide-area network without having to substantially delay the audio signal.

***Allowable Subject Matter***

8. ***Claims 65-66 and 85*** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Van Kim T. Nguyen whose telephone number is 571-272-3073. The examiner can normally be reached on 8:00 AM - 4:30 PM.


Art Unit: 2151

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Van Kim T. Nguyen  
Examiner  
Art Unit 2151

vkn

  
**ZARNI MAUNG**  
**ASSISTANT PATENT EXAMINER**